

Serial No. 09/922,066
Filed: August 3, 2001
Amendment and Response to Office Action

REMARKS

With entry of the present amendment, claims 1 to 67, 69, and 71 to 77 are pending. New claims 71 and 72 are subgeneric to claim 1. Claim 71 recites compounds where option (a) for R¹ is halogen, and claim 72 recites compounds where option (a) for R¹ is hydrogen. Claims 73 to 76 correspond to original claims 4 to 6 and 35 and depend from new claim 72. Claims 4 and 35 have been amended to depend from claim 71. New claim 77 recites pharmaceutical compositions comprising a compound of claim 71. Claims 39, 44, and 45 have been amended to correct a minor typographical error by superscripting the "2" of "R²." Claim 3 has been amended to correct the definition of R to correspond to the disclosure at paragraphs [0007] and [0025] of the specification. The new and amended claims are supported by the specification and claims as originally filed. No new matter has been added by these amendments.

The Director is authorized to charge Deposit Account No. 08-2525 in the amount of \$174.00 for additional claims fees. The Director also is authorized to charge Deposit Account No. 08-2525 in the amount of \$110.00 for the Terminal Disclaimer Fee. No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

PRIORITY CLAIM

The office action states that applicants' claim of priority cannot be granted because the claims do not recite the same subject matter as claimed in EPO 00117003, filed August 8, 2000.

Applicants traverse denial of their claim for priority for the following reasons. First, in accordance with M.P.E.P. § 201.15, the only times during *ex parte* prosecution that applicants' claim of priority is to be considered on the merits is when a reference is found with an effective

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date between the date of the foreign filing and the date of filing in the United States and when an interference is under consideration. No intervening reference has been cited in the Office Action, and there is no indication that an interference is under consideration.

Second, as noted in the M.P.E.P., a U.S. application may be entitled to the filing date of a foreign application with respect to some claims and not with respect to others (*See* M.P.E.P. § 201.15). In the instant application, applicants submit that at least claims 2 to 67, 69, and new claims 71 and 77 are entitled to priority of EPO 00117003.

The office action states that the variables R^1 and R^2 of instant claim 1 are recited in a different way than the claims of the EPO document. Applicants note that it is not necessary for the instant claims to find support in the claims of the priority document, but in the document as a whole. Comparison of the instant claims and EPO 00117003 reveals that the definition of R^2 in each document is identical. With regard to R^1 , claim 1 differs from the priority document in that R^1 also can be hydrogen. New claim 71 has been added to the instant application. The scope of this claim is the same as the disclosure on pages 1 to 3 of EPO 00117003. A further review of the instant claims indicates that at least claims 2 to 67, 69, 71, and 77 are fully supported by the disclosure of EPO 00117003 and are entitled to a claim of priority of the EPO document.

For at least these reasons, applicants respectfully request reconsideration and granting of applicants' claim for priority.

**REJECTION OF CLAIMS 1 TO 9, 13 TO 15, 35, 39 TO 45, 50, 51, AND 69 UNDER THE JUDICIALLY
CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claims 1 to 9, 13 to 15, 35, 39 to 45, 50 to 51, and 69 stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,297,375 to Bos, et al. ("*Bos*"). In making this rejection, the Office Action states that the conflicting claims,

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although not identical, are not patentably distinct because claim 1 of *Bos* encompasses the subject matter of the instant claims in certain instances. The description regarding the overlap of subject matter is confusing to applicant.

Applicants submit herewith a Terminal Disclaimer over U.S. Patent No. 6,297,375, rendering this rejection moot.

REJECTION OF CLAIMS 1, 3 TO 9, 13 TO 15, 35, 39 TO 45, 50 TO 51, AND 69 UNDER 35 USC § 102(B) OVER U.S. PATENT NO. 4,745,123

Claims 1, 3 to 9, 13 to 15, 35, 39 to 45, 50 to 51, and 69 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,745,123 to Butler et al. ("*Butler*"). The Office Action states that the instant compounds read on the reference where R⁴ is phenyl or phenyl substituted with halogen, alkyl, or alkoxy; R³ is COR'R" where R' is hydrogen or alkyl and R" is substituted phenyl alkyl; X is COCH₂-substituted phenyl; R¹ is -(CR'R")_m-R⁵ and R⁵ is hydrogen; and m is 0. The Office Action further states that the compounds numbered 7, 46, 33, and 34 are encompassed by instant claim 1.

Applicants traverse this rejection for the following reasons. It is well established that a claim is anticipated only if each and every element of the claim is described in a single reference. The compounds of formula I described in *Butler* contain a piperidene ring, a non-aromatic six-membered ring having one ring nitrogen atom. Applicants direct the Examiner's attention to the text at column 2, lines 20 through 35, of *Butler*. This text specifically states that the nitrogen-containing ring of formula I contains only one carbon-carbon double bond, which is either between the carbon atoms numbered 3 and 4 or between carbon atoms numbered 4 and 5 of the formula. In contrast the instantly claimed compounds contain a pyridine ring, an aromatic six-membered ring having one ring nitrogen atom. Thus, Applicants compounds differ significantly from the compounds described in *Butler*.

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With regard to the five specific compounds cited in the office action, applicants provide the following remarks. Compounds 19, 33, 34, and 46 also contain a piperidine rather than a pyridine ring as discussed above. Thus, these compounds do not anticipate the instant claims. Compound 7, does contain a pyridine ring. This compound is a generic intermediate in the process for making compounds of formula I, which is not wholly encompassed by the instant claims. Thus, this compound also does not anticipate the instant claims.

For at least these reasons, applicants respectfully request reconsideration and withdrawal of this rejection.

REJECTION OF CLAIMS 68 UNDER 35 USC § 112, FIRST PARAGRAPH

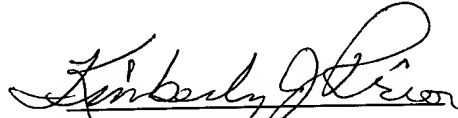
Claim 68 stands rejected under 35 USC § 112, first paragraph, as not enabling for the full scope of the claim. In making this rejection, the Office Action states that while the claim is enabling for the treatment of headaches, it is not enabled for the treatment of all other diseases encompassed by the claim. While applicants submit that the full scope of the claim is enabled, applicants have chosen to cancel the claim, rendering this rejection moot. Applicants reserve the right to pursue the subject matter of this claim in a divisional application.

The foregoing amendment is fully responsive to the Office Action issued June 11, 2003. Applicants submit that Claims 1 to 67, 69, and 71 to 77 are allowable. Early and favorable consideration is earnestly solicited.

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If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,



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